

### REMARKS

The specification has been amended as required by the Examiner.

Method claims 1-4, as well as apparatus, system and article claims 10-21, have been canceled without prejudice to their being included in one or more continuing applications. By canceling those claims, applicant has reduced the remaining issues.

Method claims 5-9, which previously depended from claim 1, have been rewritten in independent form. Claims 22-25 are apparatus claims, which correspond to method claims 4-8, respectively. Claims 26-29 are article claims that correspond to method claims 4-8, respectively.

Applicant respectfully requests entry of the amendments.

#### Allegedly admitted prior art

Applicant disagrees with the Office action's statements regarding any alleged admission of prior art (see page 3-4). There is no requirement that applicant's reply discuss every ground for allowance of the claims. Applicant's reply to the previous Office action was believed to include sufficient grounds for distinguishing the claims from the cited prior art. Indeed, the basis of rejection of the claims in the previous Office action was not reiterated in the present Office action, indicating that applicant had overcome the earlier rejections.

*In re Chevenard*, cited in the Office action, is distinguishable because, in that case, the rejected claims already were on appeal before the CCPA and, therefore, the Examiner no longer had an opportunity to provide additional evidence.

For the record, applicant does not make any admission regarding the section of the Office action entitled "Admitted Prior Art."

#### Claims 5-8 and 22-29 are patentable over the '642 patent

In the Office action, claims 1-8 and 10-21 were rejected as anticipated by U.S. Patent No. 6,449,642 ("the '642 patent"). The rejection of claims 1-4 and 10-21 is moot because those claims have been canceled. Applicant respectfully traverses the rejection of the other claims.

Claims 5-8 recite methods that include automatically loading a network protocol on a computer in response to a process-initiating event, and automatically binding an existing network adapter to the network protocol.

As recited in claim 5, the process-initiating event includes selecting a shortcut to a shared network location from the computer. The Office action alleges that such a process-initiating event is disclosed by the '642 patent at col. 8, lines 46-60. That is incorrect.

According to the pending claims, the process-initiating event occurs *before* the network protocol is automatically loaded on the computer because the "automatically loading" occurs "in response" to the process initiating event.

In contrast, the section of the '642 patent identified by the Office action as allegedly corresponding to the process initiating event of pending claim 5 relates to FIG. 18. That figure describes details of the execution of the installation manager, in other words, details of step 66 of FIG. 2 (*see, e.g.,* col. 8, lines 37-38). Execution of the installation manager in step 66 occurs *after* step 64. Step 64 identifies execution of the client set-up program, which includes installing a conventional network protocol on a client computer and binding the protocol to a network interface card (NIC) (*see* col. 7, lines 25-57; FIG. 17). Therefore, the disclosure of the '642 patent identified by the Office action as allegedly corresponding to the process initiating event of claim 5 occurs *after* installation of the network protocol; installation of the network protocol does not occur "in response" to those events. At least for those reasons, method claim 5, as well corresponding apparatus and article claims 22 and 26, are not anticipated by the '642 patent.

As recited in claim 8, the process-initiating event is part of a user login sequence to the computer. The Office action alleges that such a process-initiating event is disclosed by the '642 patent at col. 8, lines 30-36. That is incorrect for reasons similar to those discussed in connection with claim 5.

In particular, the events disclosed by the '642 patent at col. 8, lines 30-36 occur *after* step 64, which as explained above, identifies execution of the client set-up program, including

installing a conventional network protocol on a client computer and binding the protocol to an NIC. Therefore, the disclosure of the '642 patent identified by the Office action as allegedly corresponding to the process initiating event of claim 8 also occurs *after* installation of the network protocol; installation of the network protocol does not occur "in response" to those events. At least for those reasons, method claim 8, as well corresponding apparatus and article claims 25 and 29, are not anticipated by the '642 patent.

As recited in claim 6, the process initiating event includes executing an operating system command line. Such a command line may be executed in a manner that is transparent to the user (*i.e.*, without the user taking any action).

The Office action refers to FIG. 3a and the associated text of the '642 patent as allegedly disclosing such an event. That is incorrect. FIG. 3a of the '642 refers to a user's invoking the client generated program. As illustrated by FIG. 3a, the user must click the box labeled "OK" to launch the Set-Up Computer Wizard (SCW). That does not involve executing an operating system "command line" as recited in pending claim 6. At least for that reason, claim 6, as well as corresponding apparatus and article claims 23 and 27, are not anticipated by the '642 patent.

As recited in claim 7, the process-initiating event is part of a "software" setup program execution. Thus, the claimed technique can be embedded, for example, as part of a software setup process, such as the setup of database software, a firewall, etc., so that the computer is configured automatically during the software installation process.

The section of the '642 patent (col. 7, line 42 – col. 8, line 29) identified by the Office action as allegedly corresponding to the process initiating event of claim 7 relates to a "client setup program." That is different, however, from executing a "software" setup program, as recited in pending claim 7. At least for that reason, claim 6, as well as corresponding apparatus and article claims 24 and 28, are not anticipated by the '642 patent.

Claim 9 is patentable over the '642 patent

Claim 9 was rejected as unpatentable over the '642 patent in view of information allegedly admitted as prior art. Applicant respectfully traverses that rejection.

Claim 9 also recites a method that include automatically loading a network protocol on a computer in response to a process-initiating event, and automatically binding an existing network adapter to the network protocol. The process initiating event is part of a mass deployment of the new network protocol.

Even if the information in paragraph 5.b of the Office action were indeed prior art, there would have been no suggestion to modify the '642 patent to obtain the subject matter of claim 9. As discussed by the Court of Appeals for the Federal Circuit, a claimed invention is unpatentable due to obviousness if the differences between it and the prior art "are such that the subject matter as a whole would have been obvious at the time the invention was made to a person of ordinary skill in the art." 35 U.S.C. § 103(a).

Although a single prior art reference may, in appropriate circumstances, render a claim obvious, there must be showing of a suggestion or motivation to modify the teachings of that reference to the claimed invention in order to support the conclusion of obviousness. *In re Kotzab*, 217 F.3d 1365, 1370 (Fed. Cir. 2000) (reversing conclusion of obviousness).

A single line in a reference may not be taken out of context and relied upon with the benefit of hindsight to show obviousness. *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.*, 796 F.2d 443, 448 (Fed. Cir. 1986). The mere fact that the prior art reference could be modified does not satisfy the requirements for a finding of obviousness. *In re Laskowski*, 871 F.2d 115, 117 (Fed. Cir. 1989); *In re Mills*, 916 F.2d 680, 682 (Fed. Cir. 1990). Instead, the suggestion or motivation to modify the prior art must be "clear and particular." *See, e.g., C.R. Bard, Inc. v. M3 Sys., Inc.*, 157 F.3d 1340, 1352, (Fed. Cir. 1998); *Teleflex, Inc. v. Ficosa North Am. Corp.*, 299 F.3d 1313 (Fed. Cir. 2002).

As explained by the Court of Appeals for the Federal Circuit:

While the test for establishing an implicit teaching, motivation, or suggestion is what the combination of [ ] two statements of [the prior art reference] would

have suggested to those of ordinary skill in the art, the two statements *cannot be viewed in the abstract*. Rather, they must be considered *in the context of the teaching of the entire reference*. Further, a rejection cannot be predicated on the mere identification in [the prior art reference] of individual components of claimed limitations. Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed.

*In re Kotzab*, 217 F.3d at 1371 (emphasis added).

The requirement of a clear and particular suggestion or motivation prevents the use of improper hindsight based, for example, on the applicant's own disclosure as a blueprint for forming a faulty obviousness argument. *See, e.g., In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998); *Ecolchem, Inc. v. Southern California Edison Co.*, 56 USPQ2d 1065, 1072-73 (Fed. Cir. 2000). As explained by the Court of Appeals for the Federal Circuit:

Close adherence to [the required] methodology is especially important in the case of less technologically complex inventions, where the very ease with which the invention can be understood may prompt one 'to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.'"

*In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999).

In contrast to the subject matter of claim 9, the entire disclosure of the '642 patent is directed toward integrating a single client computer into a network. FIG. 16, referred to by the Office action, actually teaches away from a mass deployment because it specifically directs the user to select "*the* computer to setup." The fact that there may be more than one computer from which to choose does not suggest that multiple computers may be "setup" as part of a mass deployment or that it would be desirable to do so. Indeed, some of the operations performed by the system disclosed in the '642 patent would not be easily integrated (if at all) into a mass deployment system. For example, the '642 patent states that the SCW extracts information from the user's account, and subsequently prompts the user to select the application programs to be

installed on the client computer. If the client computer is new to the network, the SCW creates a set-up diskette that the user takes back to the client computer to launch the client set-up program (col. 1, line 52 – col. 2, line 1). In a mass deployment system, requiring users to perform such tasks would not make sense.

There is simply no “clear and particular” suggestion to modify the ‘642 patent so as to obtain the subject matter of claim 9, regardless of whether the information in paragraph 5.b of the Office action is, or is not, prior art. At least for foregoing reasons, applicant respectfully requests reconsideration and withdrawal of the rejection of claim 9.

#### Summary

It is believed that all of the pending claims have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

Applicant respectfully requests allowance of the pending claims.

Applicant : Rajasekhar Sistla  
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REMARKS

Enclosed is a check for excess claim fees. Please apply any other charges or credits to deposit account 06-1050.

Respectfully submitted,

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Samuel Borodach  
Reg. No. 38,388

Fish & Richardson P.C.  
Citigroup Center - 52nd Floor  
153 East 53rd Street  
New York, NY 10022-4611  
Telephone: (212) 765-5070  
Facsimile: (212) 258-2291